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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1944.

No. 382

SELCHOW & RIGHTER COMPANY,
Petitioner,

vs.

WESTERN PRINTING & LITHOGRAPHING COMPANY and WHITMAN PUBLISHING COMPANY,
Respondents.

PETITION OF SELCHOW & RIGHTER COMPANY FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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MC CORMICK AND HENDERSON, INC., CHICAGO

SELCHOW & RIGHTER COMPANY,
Petitioner,

vs.

WESTERN PRINTING & LITHOGRAPHING COMPANY and WHITMAN PUBLISHING COMPANY,
Responednts.

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PETITION OF SELCHOW & RIGHTER COMPANY FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Selchow & Righter Company,* respect-

* Petitioner is sometimes referred to herein as plaintiff and respondents as defendants.

fully prays for a writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit to review the judgment of that Court entered on the 25th day of May, 1944 (R. Vol. II, p. 827), in a case numbered and entitled on its docket No. 8277, Selchow & Righter Company, Plaintiff-Appellant, vs. Western Printing & Lithographing Company and Whitman Publishing Company, Defendants-Appellees, affirming the decision of the United States District Court for the Eastern District of Wisconsin.

A petition for rehearing was duly presented to the Circuit Court of Appeals, and was denied on June 20, 1944 (R. Vol. II, p. 828).

A certified transcript of the record in this case, including the proceedings in the Circuit Court of Appeals, is filed herewith.

Summary Statement of Matter Involved.

Plaintiff-petitioner, Selchow & Righter Company, a New York corporation, brought this suit in the District Court for the Eastern District of Wisconsin against defendants-respondents Western Printing & Lithographing Company and the latter's wholly owned subsidiary, Whitman Publishing Company, both Wisconsin corporations. The complaint charged that the defendants, by the manufacture and sale of board and counter game sets bearing the name "Parchesi" for the playing of a pursuit game resembling backgammon (throughout identified as defendants' "blue game"), were infringing plaintiff's registered trade-mark "Parcheesi," No. 123,033 (R. Vol. I, pp. 7-11), which the plaintiff and its predecessors had applied to essentially identical paraphernalia for over seventy years; and that

the same acts constituted both an invasion of plaintiff's common law rights in its trade-mark "Parcheesi," and unfair competition (R. Vol. I, pp. 2-6). Defendants began to market their "blue game" sets bearing the notation "Parchesi" in 1939; previously they had marketed essentially identical game sets under the notation "India".

Subsequently, plaintiff filed a supplemental complaint (R. Vol. I, pp. 19-20) containing like charges based upon the expressed intention of the defendants to manufacture and sell the same paraphernalia (throughout identified as defendants' "red game") bearing the name "Pachisi" instead of "Parchesi."

Defendants' so-called "blue game" is exemplified by Exhibit 3 (R. Vol. I, p. 15); its "red game" by Exhibit 4 (R. Vol. I, p. 21).

The District Court granted a temporary injunction in favor of plaintiff (29 F. Supp. 569); and that ruling was affirmed by the court below (112 F. (2d) 430). After final hearing, however, the District Court vacated the temporary injunction (R. Vol. II, p. 787) on the ground that the defendants had discontinued the use of the name "Parchesi," and had indicated they had no intention of using that name in the future (47 F. Supp. 322, 327; R. Vol. II, p. 775). The District Court also entered judgment dismissing the complaint and supplemental complaint (R. Vol. II, p. 787). The reasons for the decision appear in the following extracts from the opinion of the District Court (47 F. Supp. 322, 323, 324, 326; R. Vol. II, pp. 768, 770, 773):

> "* * * Since 1869 plaintiff and its predecessors have used the name 'Parcheesi' as a trade-mark on board and counter games manufactured and sold in interstate commerce. * * *

> "For many years prior to 1869 a game similar to plaintiff's 'Parcheesi' was played in India. The highest count that could be made in the Indian game was twenty-five, and the Hindustani or Hindi word for 'twenty-five' sounded very similar to 'Patcheesi,' 'Parcheesi,' or 'Pachisi.' In fact, the game in India has come to be known as 'Pachisi' and is often referred to as the national game of India."
>
> * * * * * *
>
> "The testimony in the case at bar establishes that the correct spelling of the Indian name is 'Pachisi.' While it is true that this is the Indian word for 'twenty-five,' it is also the name of the Indian game which is similar to plaintiff's game of 'Parcheesi' as well as to the defendant's proposed game. * * *"

Thereupon the District Court applied the same rule that had been laid down in 1904 by the United States Circuit Court for the Southern District of New York in a case involving the same trade-mark "Parcheesi," and wherein predecessors in title of the petitioner were plaintiffs. That case was *Selchow et al.* v. *Chaffee & Selchow Mfg. Co.*, 132 Fed. 996. There Judge Ray enjoined the defendant from using the name "Parcheesi" in connection with games not manufactured or sold by the plaintiffs; but he pointed out, at pages 999-1000 of 132 Fed.:

> "* * * It is not intended to hold that defendant may not use the Hindoostanee name of this game in putting it on the market and selling it, for that everyone has the right to do. * * *"

This limitation on the injunction was carried into the interlocutory decree entered by Judge Ray (Defendants' Exhibit 31, R. Vol. II, pp. 764, 765).

It will be brought out, however, in the brief in support of the present petition, that this early *Selchow* case is not

a presently applicable authority, for the reasons that it was decided prior to the enactment of the Trade-Mark Act of 1905, and that the plaintiff is the owner of the trade-mark "Parcheesi," duly registered under that Act.

The salient facts of record which plaintiff relies upon to show that, as matter of law, its trade-mark "Parcheesi" is not descriptive of its game sets or paraphernalia, are set out in Appendix B at the end of this brief.

Jurisdiction.

(1) The judgment was rendered in a non-jury action brought under the Trade-Mark Statutes of the United States to determine the issues of the validity and infringement of a trade-mark issued under the authority of Section 5 of the Act of 1905, U. S. Code, Title 15, Section 85, specifically under the provisions of the so-called "ten-year clause" of that Act.

(2) The statutes under which the jurisdiction of this Court is invoked are Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925 (U.S.C., Title 28, Sec. 347 (a); Section 18 of the Trade-Mark Act of 1905 (U.S.C., Title 15, Sec. 98) and R.S. § 1008, as amended by the Act of February 13, 1925 (U.S.C., Title 28, Sec. 350).

(3) The decision below was entered on May 24, 1944 (R. Vol. II, p. 827). Petition for rehearing was filed on June 9, 1944 (R. Vol. II, p. 827), and was denied on June 20, 1944 (R. Vol. II, p. 828).

Questions Presented.

(1) Is it a condition precedent to the determination whether or not there is infringement of a trade-mark, validly registered under the ten-year clause of the Trade-Mark Act of 1905 and not abandoned, that the trade-mark owner shall make an affirmative showing that the mark so registered has acquired a secondary meaning?

(2) If a mark has been registered under the ten-year clause of the Act of 1905, is there a presumption of secondary meaning attaching thereto which is rebuttable only by a showing that the registration is invalid, or that the trade-mark has been abandoned by its owner?

(3) May the local law governing trade-marks and unfair competition be resorted to in order to resolve the question whether an allegedly infringing mark is a colorable imitation of a trade-mark registered under the ten-year clause of the Act of 1905, where liability for such colorable imitation is provided by the same Act (U. S. Code, Title 15, Sec. 96)?

(4) Where a trade-mark is an *idem sonans* of a word in a foreign language, and, at the time of its adoption as a trade-mark the foreign word was unintelligible and non-descriptive to the general public, is one charged with infringement thereof entitled to assert that the mark is descriptive of the trade-marked goods when he affixes the alleged infringing mark to goods which are identical with the trade-marked goods, but which, at the most, resemble only superficially the goods (in the country of the foreign language) that constitute the basis for asserted descriptiveness of the trade-mark?

(5) If the primary significance of a word in a foreign language is a number, and that word is applied to a game

of chance (played in the country of the foreign language) because of special circumstances under which that number may fall, is that word (number) descriptive, within the meaning of Section 5 of the Trade-Mark Act of 1905, when applied as a trade-mark to game sets in the use of which,—because of the absence of those special circumstances,—that number has no significance whatsoever?

(6) Where the primary significance of a word in a foreign language is a number, and that number,—because it is the highest that can be thrown,—is used in the country of that language as the name of a game of chance, but only when the game is played with unmarked sea shells and not when the game is played with stick dice, is that word (or number) descriptive when applied as a trade-mark in the United States to a similar, but not identical game set, where the implements to be thrown, supplied as a part of the game set, are ordinary cube dice, and the number, constituting the primary meaning of that word in the foreign language, cannot be thrown with the cube dice?

(7) Is plaintiff's trade-mark "Parcheesi"—registered under the ten-year clause of the Trade-Mark Act of 1905,—infringed by defendants' use of "Pachisi" when applied to the same type of board and counter game set as that manufactured and sold by plaintiff under its trade-mark?

(8) If the answer to Question (7) be in the affirmative, would the result be altered by the facts that on defendants' game sets the name of one of the defendants is displayed prominently along with "Pachisi," and that the dress of defendants' goods, as well as the color of the label thereon, differs markedly from that of the plaintiff?

Reasons Relied on for the Allowance of the Writ.

(1) The decision of the Court of Appeals for the Seventh Circuit involves an important question touching the construction, application and scope of an Act of Congress, which has not been, but should be, settled by this Court,—namely, whether local law or federal law should be applied in resolving issues (a) of infringement of a trade-mark registered under the ten-year clause of the Act of 1905 and (b) of the character and scope of the redress available to the owner of a trade-mark so registered.

(2) In holding that the common law was to be looked to in order to determine whether plaintiff is entitled to exclude defendants from the use of the word "Pachisi,"—as embodied in their red game—the Court of Appeals rendered a decision not only in conflict with applicable decisions of this Court (*Thaddeus Davids Co.* v. *Davids,* 233 U. S. 461; *Sola Electric Co.* v. *Jefferson Electric Co.,* 317 U. S. 173), but also in conflict with its own decision in *Philco Corp.* v. *Phillips Mfg. Co.,* 7 Cir., 113 F. (2d) 663, and in conflict with the decision of the Circuit Court of Appeals for the First Circuit in *Dwinell-Wright Co.* v. *National Fruit Product Co.,* 149 F. (2d) 618.

(3) In holding valid plaintiff's registration of its trade-mark "Parcheesi" under the ten-year clause of the Act of 1905, and yet holding, in effect, that plaintiff had the burden of showing that its trade-mark so registered had acquired a secondary meaning, the Circuit Court of Appeals decided a federal question in a way that conflicts with applicable decisions of this Court (*Thaddeus Davids Co.* v. *Davids,* 233 U. S. 461).

(4) In holding, in effect, that acquisition of a secondary meaning by a trade-mark cannot be adjudged to exist

in the absence of a showing that the purchasing public knows the name of the manufacturer of the goods to which the trade-mark is affixed, the Circuit Court of Appeals applied what it deemed to be local law to the decision of a federal question, namely, the question of infringement of a federal, statutory trade-mark.

(5) In *Pecheur Lozenge Co.* v. *National Candy Co.*, 315 U. S. 666, 667, this Court said that

> "* * * Both courts below having failed to consider or apply local law, we granted certiorari, 314 U. S. 603, * * * in order to determine whether local law or federal law should have been applied in a suit for infringement of a trademark registered under the Trademark Act of 1905, 33 Stat. at L. 724, * * *."

However, this Court was prevented from determining that question because, in the later review on the merits, it was disclosed that the labels of the petitioner there had been registered, not under the Trademark Law, but under the Copyright Law.

If anything, the case at bar calls more clearly for allowance of the writ of certiorari than did the *Pecheur* case; for both courts below applied common or local law tests of unfair competition to the question of infringement of a trade-mark registered under the Act of 1905 in the face of specific tests of infringement provided in Section 16 of that Act (U. S. C., Title 15, Section 96).

(6) The holding of the court below, in effect, that an *idem sonans* of petitioner's trade-mark "Parcheesi," namely, the Hindi word "pachisi,"—the primary meaning of which is "twenty-five,"—is descriptive of petitioner's game sets, involves an important question touching the construction of Section 5 of the Trade-Mark Act of 1905, which has not been, but should be, settled by this Court.

The same holding, moreover, is in conflict with the decision of the Circuit Court of Appeals for the Second Circuit in *LeBlume Import Co.* v. *Coty*, 293 Fed. 344.

Prayer.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Seventh Circuit, to the end that this cause may be reviewed by this Court; that the judgment of the Circuit Court of Appeals be reversed; and that petitioner be granted such other and further relief as may be proper.

Respectfully submitted,

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LEON F. SHACKELL,
Of Counsel.

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

I.

Opinions of the Courts Below.

The opinion of the Circuit Court of Appeals for the Seventh Circuit is reported in 142 F. (2d) 707, and is printed in the record, at Vol. II, pages 823 to 827. The opinion of the District Court is reported in 47 F. Supp. 322, and is printed in the record, at Vol. II, pages 768 to 775. The Circuit Court of Appeals rendered no opinion explanatory of its denial of plaintiff's petition for rehearing.

II.

Jurisdiction.

The grounds on which the jurisdiction of this Court is invoked are set forth at page 5 *ante* of the accompanying petition.

III.

Statement of the Case.

The material facts and the questions involved are set forth in the foregoing petition, to which reference is made.

IV.

Specification of Errors.

The Circuit Court of Appeals for the Seventh Circuit erred:

(1) In failing to apply the federal statutory tests of infringement of a statutory trade-mark registered under the Trade-Mark Act of 1905—the tests being set forth in Section 16 of that Act (U. S. C., Title 15, Section 96)—but, instead, in applying the tests of common or local law.

(2) In approving the conclusion of the District Court that

> "the applicable tests in this case were *the old common law rules of unfair competition* with the exception of the requirement of proof of an attempt to defraud."*

(3) In holding that

> "the only question left for determination is whether the plaintiff is entitled *under the common law* to exclude the defendant from the use of the word 'Pachisi.'"

(4) In applying the common law rule, as adopted in *Selchow* v. *Chaffee & Selchow Co.*, C. C. 132 Fed. 996,—a case decided prior to the enactment of the Trade-Mark Act of 1905,—and in holding that defendants

> "had the right to use the name 'Pachisi,' which was the correct name for a game in the Hindu language * * *."

(5) In holding that proof of the acquisition of a secondary meaning by the trade-mark "Parcheesi" was a

* Unless otherwise indicated, emphasis is ours.

necessary element in plaintiff's case for infringement of its statutory trade-mark instead of affording a presumption of secondary meaning as this Court, in the *Davids* case, has said follows from registration under the ten-year clause of the Act of 1905.

(6) In approving the ruling of the District Court that the trade-mark "Parcheesi" had not acquired a secondary meaning.

(7) In affirming the judgment of the District Court which involved the holding that, although plaintiff is the owner of a valid registration of the trade-mark "Parcheesi," still it does not have the right to exclude others from using the notation "Pachisi,"—obviously a "colorable imitation" of plaintiff's "Parcheesi" within the meaning of Section 16 of the 1905 Act.

(8) In affirming the holding of the District Court that plaintiff's registration of the trade-mark "Parcheesi" is valid, and that the mark has not been abandoned, and yet in failing to afford the plaintiff any protection as owner of that trade-mark.

(9) In failing to hold that plaintiff's statutory trade-mark "Parcheesi" is not "descriptive of the goods, with which they are used, or of the character or quality of such goods,"—within the meaning of Section 5 of the Trade-Mark Act of 1905 (U. S. C. Title 15, Section 85)—as applied to plaintiff's and also to the defendant's board and counter game sets.

(10) In affirming the ruling of the District Court vacating the temporary injunction theretofore granted.

(11) In affirming dismissal of plaintiff's supplemental complaint and thereby authorizing defendants to market their proposed red game.

V.

Argument.

It is believed that the questions presented and the reasons for allowance of the writ of certiorari, as set forth in the foregoing petition (pp. 6-10) sufficiently summarize the argument.

Proposition 1. The categories of trade-marks that may be registered under the Act of 1905, the rights of the owner of a trade-mark so registered, the tests of liability for their violation, the forms of action for infringement thereof, the defenses available and the remedies for infringement are all encompassed within the provisions of that Act. Consequently, all questions involved in an action for infringement of a trade-mark so registered are federal questions, and their decision is governed by federal law and not by local law relating to common law trade-marks or unfair competition.

It has been pointed out, in the "Summary Statement of the Matter Involved," that plaintiff brought its action for infringement of its trade-mark "Parcheesi," registered under the Act of 1905; and that plaintiff included counts for infringement of its common law rights in the same trade-mark, and for unfair competition.

Although the District Court entered judgment for the defendants, it held plaintiff's registration to be valid and that plaintiff is the owner of the trade-mark "Parcheesi" and of "the business and good will connected therewith" (Conclusions of Law Nos. 2 and 3, R. Vol. II, p. 786); and that the trade-mark has not been abandoned (Finding of Fact No. 13, R. Vol. II, p. 781). The defendants took no cross-appeal; consequently they are concluded by the rulings adverse to them,—namely, that plaintiff is the owner

of a valid registered trade-mark which has not been abandoned; and of the business and good will connected therewith.

LeTulle v. *Scofield*, 308 U. S. 415, 421, 422;
Morley Construction Co. v. *Maryland Casualty Co.*, 300 U. S. 185, 191;
Alexander v. *Cosden Pipe Line Co.*, 290 U. S. 484, 487.

Thus, conclusively adjudged to be the owner of a valid registration of its trade-mark "Parcheesi," petitioner feels that it need no longer rely upon asserted infringement of its common law rights and unfair competition by the respondents. Therefore, in seeking review by this Court of the adverse judgment of the court below, petitioner proposes to rely solely upon the rights, tests of infringement and remedies available to it under the Act of 1905.

The presently pertinent provisions of the Trade-Mark Act of 1905 (U. S. C., Title 15, Sections 81-109) are reproduced in Appendix A to this petition and brief.

The Act provides a completely adequate basis for the decision of every question that can arise in an action for the infringement of a trade-mark registered thereunder. Every such question is a federal question; and the answer thereto is to be derived from that federal Act and to be governed by federal law.

Pecheur Lozenge Co. v. *National Candy Co.* has been cited above under plaintiff's fifth reason for allowance of the writ of certiorari. There this Court had intended to, but, because the facts would not permit, did not, decide the question whether local law or federal law should be applied in a suit for infringement of a trade-mark regis-

tered under the Act of 1905. However, the later decision of this Court in *Sola Electric Co.* v. *Jefferson Electric Co.*, 317 U. S. 173,—wherein this Court reaffirmed broadly a doctrine that it had announced in earlier decisions,—indicates clearly that where legal relations lie within the compass of a valid federal statute (such as the Trademark Act of 1905) questions touching those legal relations are federal questions and are to be answered by applying the provisions of the statute and federal law, and not by applying local law in conflict therewith.

In the *Sola* case this Court said, at page 176 of 317 U. S.:

> "It is familiar doctrine that the prohibition of a federal statute may not be set at naught, or its benefits denied, by state statutes or common law rules. In such a case our decision is not controlled by *Erie R. Co.* v. *Tompkins*, 304 U. S. 64, 82 L. ed. 1188, 58 S. Ct. 817, 114 A. L. R. 1487. There we followed state law because it was the law to be applied in the federal courts. But the doctrine of that case is inapplicable to those areas of judicial decision within which the policy of the law is so dominated by the sweep of federal statutes that legal relations which they affect must be deemed governed by federal law having its source in those statutes, rather than by local law." (Citing cases.) "When a federal statute condemns an act as unlawful, the extent and nature of the legal consequences of the condemnation, though left by the statute to judicial determination, are nevertheless federal questions, the answers to which are to be derived from the statute and the federal policy which it has adopted. To the federal statute and policy, conflicting state law and policy must yield." (Citing authorities.)

The *Sola* case did not involve trade-mark matters. Nevertheless, in deciding the case of *Philco Corp.* v. *Phillips Mfg. Co.*, 133 F. (2d) 663,—which, like the case at bar,

involved counts for infringement of a trade-mark registered under the Act of 1905, for common law trade-mark infringement and for unfair competition—the court below unquestionably applied the doctrine of the *Sola* case; for it said, at pages 671 and 672 of 133 F. (2d):

> "* * * The policy of a statute which Congress has enacted under its constitutional power to regulate interstate commerce may not be defeated or obstructed by State law, whether decisional," (citing cases) "or statutory," (citing cases). "Through the Trade-Mark Acts of 1905 and 1920 Congress has occupied that part of the field of unfair competition in interstate commerce having to do with 'passing off' effected solely by the use of a trade-mark. The intention of Congress was to achieve uniformity within the area occupied. In so far as State law conflicts with this policy of the Trade-Mark Acts, it must yield to the superior federal law. Clause 2, Article VI, Constitution of the United States. * * *"

In a footnote at this point the Court of Appeals said that

> "The reason this question was not raised prior to the Erie case was that under the 'federal rule' the federal courts provided uniform protection for trade-marks which was more extensive than the protection usually allowed by State courts."

Thereafter the Court of Appeals said:

> "It goes without saying that plaintiff has no action for common law trade-mark infringement under State law. Registration of plaintiff's trade-mark rendered all questions concerning its use and protection in interstate commerce questions of federal law, and federal law is supreme."

Again, in *Dwinell-Wright Co.* v. *National Fruit Product Co.*, 140 F. (2d) 618, at page 620, the Circuit Court of Appeals for the First Circuit said that

> "* * * The court below concluded that on the question of infringement of registered trade-marks the applicable law is federal statutory law, and where that is ambiguous or silent, federal case law, and we agree."

In the case at bar, however, the court below said, at page 709 of 142 F. (2d) (R. Vol. II, p. 826):

> "* * * The District Court therefore concluded that *the applicable tests in this case were the old common law rules of unfair competition* with the exception of the requirement of proof of an attempt to defraud. See *Armstrong Paint & Varnish Works* v. *Nu-Enamel Corp.*, 305 U. S. 315, 59 S. Ct. 191, 83 L. Ed. 195. The ruling of the District Court in this respect, we think, was proper, and the only question left for determination is whether the plaintiff is entitled *under the common law* to exclude the defendant from the use of the word 'Pachisi.'"

Incidentally, the *Nu-Enamel* case, cited by the court below, can have no application to the present suit, because that case involved a trade-mark registration under the Act of 1920, which affords a registrant thereunder only the right to sue in the federal courts irrespective of diversity of citizenship but accords him none of the presumptions afforded by registration under the Act of 1905.

Petitioner submits that the matter last above quoted from the opinion of the court below affords, without more, ample reason for the issuance of a writ of certiorari. Not only has the court below thereby decided important questions of federal law which have not been, but should be, settled by this Court, but also its application of local law instead of federal law in reaching its decision conflicts with the decision of the Circuit Court of Appeals for the First Circuit in the *Dwinell-Wright* case (140 F. (2d) 618,

620), *supra*, as well as with its own decision in the *Philco* case (133 F. (2d) 663, 671, 672), *supra*.

Proposition 2. After validating the federal registration of petitioner's trade-mark "Parcheesi" the court below should have applied the statutory tests of infringement in determining respondents' liability for their use of the word "Pachisi."

In the main this proposition is but a special case coming under Proposition 1, just discussed. There are, however, additional aspects of the present proposition which seem to merit separate consideration.

The court below said, at page 709 of 142 F. (2d) (R. Vol. II, p. 826):

> "* * * There is no substantial evidence in this case to prove that there was any fraud or palming off with respect to the defendant's product unless it can be said that the word 'Parcheesi' has acquired a secondary meaning, that is to say that in the minds of the purchasing public, it means the producer rather than the product. See *Kellogg Co.* v. *National Biscuit Co.*, 305 U. S. 111, 59 S. Ct. 109, 83 L. Ed. 73; *Steem-Electric Corp.* v. *Herzfeld-Phillipson Co.*, 7 Cir., 118 F. 2d 122. The District Court was of the opinion that that word had not acquired a secondary meaning. That court very properly said: 'Not one purchaser in a thousand would know or care whether Selchow and Righter Company was the manufacturer. The fact is that the public in general knows "Parcheesi" as a game and not as an article made by the plaintiff.' 47 F. Supp. 322, 326. * * *"

Neither the *Kellogg* case nor the *Steem-Electric* case, thus cited by the court below, is applicable to the instant case. The trade-marks involved in the *Kellogg* case were registered under the Act of 1920. In the *Steem-Electric*

case, there was one trade-mark registration under the Act of 1920, and another registration under the Act of 1905,—the latter involving a design including the words "Steem-Electric," which words were disclaimed apart from the mark; and infringement was predicated upon the use of only the words "Steam-O-Matic."

Not only did the court below fail to apply the statutory tests of infringement provided in Section 16 of the Act of 1905 (U. S. C., Title 15, Section 96), but also, as a condition precedent to the granting of any relief, it impliedly required an affirmative showing by the plaintiff that its registered trade-mark "Parcheesi" had acquired a secondary meaning. By such requirement, however, the court below brought itself into direct conflict with the decision of this Court in *Thaddeus Davids Co.* v. *Davids*, 233 U. S. 461.

In the *Davids* case this Court construed the Trade-Mark Act of 1905 with particular reference to the rights and remedies available to the owner of a trade-mark,—consisting of the surname "DAVIDS," as applied to inks—which had been registered under the ten-year clause of that Act.

The following extracts from the opinion of this Court in the *Davids* case, together with petitioner's interpolated comments, should suffice to demonstrate how conclusively that case should have constrained the court below to reach a conclusion just the opposite of the one it did reach.

In the *Davids* case at page 469 of 233 U. S., this Court, with reference to the ten-year clause, said:

> "* * * The applicant who, by virtue of actual and exclusive use, is entitled to register his mark under this clause, becomes on due registration the 'owner' of a 'trademark' within the meaning of the act, and he *is entitled to be protected* in its use as such."

In affirming the ruling of the District Court that plaintiff is the owner of a valid registration of its trade-mark "Parcheesi," and yet in affirming at the same time dismissal of the complaint and of the supplemental complaint in the face of the clearest infringement by defendants' use of an *idem sonans*, "Pachisi," the court below disregarded one of the most ancient maxims of the law,—namely, that where there is a right, there is a remedy.

Again in the *Davids* case, at pages 469-470, of 233 U. S. —after quoting tests of infringement under § 16,—U. S. C., Title 15, Section 96, this Court said:

> "* * * This provision applies to all trademarks that are within the act, including those which come under the ten-year clause, provided they are not used 'in unlawful business,' or 'upon any article injurious in itself,' or 'with the design of deceiving the public,' and have not been 'abandoned' (§21)," (U. S. C., Title 15, Section 101.)
>
> "But, while this is true, the inquiry as to the extent of the right thus secured by the statute, in the case of marks which are admitted to registration under the ten-year clause, is not completely answered. * * * Congress has admitted to registration the names or terms belonging to the class under consideration simply because of their prior use as trademarks, although they had not been such in law. Their exclusive use as trademarks for the stated period *was deemed, in the judgment of Congress, a sufficient assurance that they had acquired a secondary meaning* as the designation of the origin or ownership of the merchandise to which they were affixed. * * *"

There can be no shadow of a doubt that the sentence last above quoted means that the valid registration of a trade-mark under the ten-year clause carries with it the presumption that the trade-mark has acquired a second-

ary meaning. Indeed, in *Coca-Cola Co.* v. *Nashville Syrup Co.*, 200 Fed. 153, 155 (affirmed, C. C. A. 6th, 215 Fed. 527), Judge,—later Mr. Justice—Sanford said that Section 5 of the Act of 1905

> "* * * in effect merely gives a conclusive presumption of secondary meaning to a trade-mark in actual and exclusive use for a period of ten years. * * *"

Consequently, in affirming the ruling of the District Court that plaintiff is the owner of a valid registration of its trade-mark "Parcheesi," and yet in approving, at the same time, the ruling of the District Court that "Parcheesi" had not acquired a secondary meaning, the court below rendered a decision clearly in conflict with the decision of this Court in the *Davids* case.

And still further in the *Davids* case at page 471 of 233 U. S.—after pointing out that the reproduction, copy, or imitation, which constituted infringement of a mark registered under the ten-year clause, must be such as is calculated to mislead the public with respect to the origin or ownership of the goods, this Court said:

> "* * * This is not to say that, in this view, the case becomes one simply of unfair competition, as that category has been defined in the law; for, whatever analogy may exist with respect to the scope of protection in this class of cases, *still the right to be protected against an unwarranted use of the registered mark has been made a statutory right,* * * *."

On the other hand, in this case the court below agreed with the District Court that

> "* * * the applicable tests in this case were the *old common law rules of unfair competition* with the exception of the requirement of proof of an attempt to defraud. * * *" (142 F. (2d), at page 709 (R. Vol. II, p. 826).)

Thus, the court below rendered a decision directly in conflict with the ruling of this Court in the *Davids* case,—namely, that a case for infringement of a trade-mark registered under the ten-year clause does not become one simply of unfair competition at common law.

In the *Davids* case this Court agreed with the trial court that the defendants there had infringed the registered mark "DAVIDS" by putting "C. I. DAVIDS" at the top of their labels, and at the bottom thereof "DAVIDS MFG. CO." This Court then added, at page 472 of 233 U. S.:

> "* * * The use of the name in this manner was a mere simulation of the complainant's mark which it had duly registered; it constituted a 'colorable imitation' within the meaning of the act. * * *"

In completely analogous fashion, the use of the mark "Pachisi" by the present defendants clearly would be "a mere simulation of the complainant's mark which it had duly registered"; and would just as clearly constitute a "colorable imitation" of plaintiff's trade-mark "Parcheesi" "within the meaning of the act."

That this Court has not varied from the doctrine announced in the *Davids* case,—namely, that "the right to be protected against an unwarranted use of the registered mark has been made a statutory right," is emphasized by the fact that in *Mishawaka Rubber & Woolen Mfg. Co.* v. *S. S. Kresge Co.*, 316 U. S. 203, 205, this Court cited the *Davids* case and quoted therefrom the words last quoted above.

Petitioner submits that this Court should allow a review of the decision of the court below if only to avert the crystallization into precedent of the ruling of the Circuit Court of Appeals for the Seventh Circuit that there can be valid registration of a trade-mark under the Act

of 1905 without the registrant being afforded the protection prescribed by that Act.

Proposition 3. Petitioner's trade-mark "Parcheesi" is not "descriptive of the goods" with which it is used, "or of the character or quality of such goods," within the meaning of Section 5 of the Trade-Mark Act of 1905.

The factual basis, apparently held by the District Court as sufficient to support its holding that "Pachisi" (as well as "Parcheesi") is descriptive of plaintiff's game sets, appears in the following excerpts from the opinion of that court, at pages 324, 325, and 326 of 47 Fed. Supp.; R. Vol. II, pp. 770, 772, and 773):

> "For many years prior to 1869 a game similar to plaintiff's 'Parcheesi' was played in India. The highest count that could be made in the Indian game was twenty-five, and the Hindustani or Hindi word for 'twenty-five' sounded very similar to 'Patcheesi,' 'Parcheesi,' or 'Pachisi.' In fact, the game in India has come to be known as 'Pachisi' and is often referred to as the national game of India.
>
> * * * * * *
>
> "Plaintiff contends that the game which it manufactures is not the Hindi game of 'Pachisi' because the rules differ in certain respects. The Hindi game in evidence showed plaintiff's board is greatly similar. In each game the boards are cruciform, having a center square and four arms. In each instance the arms are divided into three pathways, and the number of divisions or sections in each pathway is practically the same. Each game is played by two to four persons, with playing pieces to be moved upon the board. The Hindi game uses cowries to determine the number of spaces which the pieces may be moved, while in plaintiff's modern version, dice are used. The primary object in each game is to get the players 'Home.' But such slight variations in the rules are not of importance. * * *

> "The testimony in the case at bar establishes that the correct spelling of the Indian name is 'Pachisi.' While it is true that this is the Indian word for 'twenty-five,' it is also the name of the Indian game which is similar to plaintiff's game of 'Parcheesi' as well as to the defendant's proposed game."

The first two of the excerpts just quoted repeat, in substance, Findings of Fact Nos. 31 and 32 (R. Vol. II, p. 785).

The substance of the above quoted observations of the District Court appears in the testimony, on direct and cross-examination, of the plaintiffs' expert, Dr. William Norman Brown, Professor of Sanskrit at the University of Pennsylvania (R. Vol. I, pp. 27-59; 145-146). Extracts from Dr. Brown's testimony, which will serve to clarify, as well as to amplify, the references of the District Court to the Indian game "similar to plaintiff's 'Parcheesi,' " to the highest count as twenty-five (pachisi) and to the use of cowries in the Hindi game, are reproduced in Appendix B to this brief.

The following are the salient, and presently pertinent, facts to be gleaned from the uncontradicted testimony of Dr. Brown presented in Appendix B:

(a) The Hindi word "pachisi" is not primarily the name of a game in India, but means "of twenty-five," and is applied to any collection of twenty-five things.

(b) The playing cloth or board in India is called "chausar" or "chaupar," and derives its name from the four arms making up its cruciform design.

(c) A game played in India on the "chausar" or "chaupar" board, using stick dice, is called "chausar" or "chaupar" (four-limbed) from the name of the playing

board; and the stick dice, usually three in number, are marked on their four long sides with spots or characters that render it impossible to make a throw "pachisi," that is, "of twenty-five."

(d) It is only when cowrie shells, without spots, are used, instead of stick dice,—so that a throw of twenty-five (usually the highest count) can be made,—that the game is known in India as "pachisi."

(e) Dr. Brown, as a boy, took to India one of plaintiff's game sets, but he was unsuccessful in playing the game with Hindi children because he used cube dice and they wanted to play with cowries. He, in turn, found it difficult to play the Indian game of "pachisi" because of the complicated system of counting attached to throws of the cowries.

To fill out, then, the factual background that was omitted by the District Court: There is no game played in India under the appellation "pachisi" wherein the moves are determined other than by throws of a number of unmarked cowrie shells. With the same playing board, if stick dice are used, the name of the game,—*i.e.*, "chaupar" or "chausar," the former being taken from the Hindi name of the board,—does not remotely resemble "pachisi." Consequently, if the defendants want to use the name "pachisi," they should be restricted to the game by that name; in other words, they should be limited to the marketing of a game set comprising a playing board substantially identical with a chaupar board or cloth, counters, and unmarked cowries.

But there is one piece of evidence, provided by the defendants themselves, which demonstrates that in a vital respect,—namely, in the location of safety points thereon, —a chaupar board does not correspond to the playing

boards of the plaintiff (and of the defendants); and, as a consequence, that a throw of twenty-five (pachisi) with cowrie shells cannot achieve the same objective on one of plaintiff's boards,—*i.e.*, jumping a counter from one safety point to another,—that is possible on a chaupar cloth. This evidence appears in Defendants' Exhibit 9, comprising Chapter XXVII, pages 257 to 262, inclusive, of "Games Ancient and Oriental and How to Play Them," by Edward Falkener (London—1892). This exhibit was received in evidence at Vol. I, page 154, of the record; and is reproduced at Vol. II, pages 714 to 727 thereof.

The presently important details of Falkener's description are (a) that certain ornamented spaces on a chaupar cloth, or board, termed "castles," serve as safety points on which pieces are free from capture; and (b) that these castles are placed on the board so that, in a number of instances, two castles are 25 spaces apart,—Falkener pointing out, "hence the name of the game." The count of 25 spaces between certain pairs of castles, specifically pointed out by Falkener (R. Vol. II, pp. 725, 726), may be verified by reference either to Falkener's photograph of a chaupar cloth (showing also stick dice and cowries) at Vol. II, page 715 of the record, or to the engraving of the cruciform playing surface at page 723.

If the relative positions of the castles on either of these Falkener illustrations of a chaupar board be compared with the relative positions of the "Safety Points" *a*, *a*, *a* on one of plaintiff's boards,—as exemplified in the diagram (R. Vol. II, p. 505) making up part of Plaintiff's Exhibit EA, consisting of instruction folders "How to Play Parcheesi," received in evidence at Vol. I, page 109 of the record,—it will be seen that the laterally positioned castles on each arm of a chaupar cloth are *four* spaces

from the end of the arm, whereas the corresponding "Safety Points" on plaintiff's board (so also on defendants' board) are *five* spaces from the end of the arm.

This apparently insignificant shift of the lateral safety points on plaintiff's (and also defendants') board from the positions occupied by corresponding castles on a chaupar board in reality is vitally material to the issue whether "pachisi" (twenty-five), or its *idem sonans*, "Parcheesi," is descriptive of plaintiff's game sets; for, in contrast with a chaupar board, there are no two "Safety Points" on plaintiff's or defendants' board that are 25 spaces apart. Hence, even though cowries were to be used in playing a game on one of plaintiff's or defendants' boards, the highest count therewith, namely, twenty-five or "pachisi," could not achieve the same objective as it might on a chaupar board,—that is, the jumping of a piece or counter from one safety point to another.

Indeed, it is highly probable that the specific positioning of the safety points on plaintiff's boards,—going back at least to the year 1871 (Plaintiff's Exhibit GD, received in evidence R. Vol. I, page 112, and reproduced at R. Vol. II, page 521),—was done advisedly and with a view to the use of ordinary cube dice; thus affording a player the possibility of being able to jump a piece from one safety point to another by making throws of 5, 7, 10, or 12 with such dice.

It results that "Parcheesi" is not descriptive as applied to plaintiff's game sets or to any characteristic of the game played therewith; and that the court below erred in so holding.

The facts involved in the case of *LeBlume Import Co.* v. *Coty*, 293 Fed. 344 (2 Cir.), furnish a close parallel to the facts summarized under the present Proposition 3 to show

that plaintiff's game set in no sense is a reproduction of the Indian game of pachisi. But the ruling of the court below is in direct conflict with that of the Circuit Court of Appeals for the Second Circuit in *LeBlume* v. *Coty*.

The case just cited involved the question whether the trade-mark "Lorigan," which had been registered under Section 5 of the Trade-Mark Act of 1905, as applied to a perfume blend or bouquet, was infringed by the use of the word "Origan" when applied to a similar blended perfume. The principal defense was invalidity of the registration of "Lorigan" on the ground of descriptiveness,—particularly in view of the fact that the trade-mark owner used the word "L'Origan" instead of the registered form "Lorigan."

The Circuit Court of Appeals for the Second Circuit said, at pages 353 and 357 of 293 Fed.:

> "* * * The word 'origan' is an English word, and one of great antiquity. The New Standard Dictionary defines it as 'wild marjoram' and states that it is 'rare.' And the Century Dictionary defines it as 'a plant of the genus Origanum; marjoram; wild marjoram; also pennyroyal.' And 'origanum' is defined in the same work as 'a genus of labiate plants of the tribe Satureineae and the subtribe Menthoideae.' It is added, 'There are about 30 species, mainly of the Mediterranean region.' While the word 'origan' has retained its currency among pharmacists and botanists, its use for many years seems to have been almost exclusively confined to them, and it has been only occasionally used in modern English literature. It is in no sense a word of common speech in English.
>
> * * * * * *
>
> "There is abundant testimony in the record to the effect that 'L'Origan' is a blend or bouquet, and that its odor is not that of any particular flower. * * *"

In holding the registration of "Lorigan" to be valid, and in affirming injunctional orders involved in the appeal the Second Circuit Court of Appeals,—having reference to the meaning of the word "descriptive," as used in Section 5 of the Trade-Mark Act of 1905,—said, at pages 351 and 358 to 359 of 293 Fed.:

> "* * * The cases show that the courts under certain circumstances protect the use of words as trade-marks, even though they suggest the ingredients, qualities or characteristics of the goods. The distinction is between words which are 'descriptive' and those which are merely 'suggestive.' * * *
>
> * * * * * *
>
> "* * * we think that a word which is not in general or common use, and is unintelligible and non-descriptive to the general public, although it may be known to linguists and scientists, may be regarded as arbitrary and fanciful, and capable of being used as a trade-mark or a trade-name; * * *."

Petitioner submits that, under a state of facts which parallels closely that in *LeBlume* v. *Coty,* its trade-mark "Parcheesi" is at the most only suggestive of its game sets; and that it is not descriptive of petitioner's goods, within the meaning of the Trade-Mark Act of 1905, where the trade-mark, at the time of its initial use in this country, prior to 1870, by petitioner's predecessor in title, was unintelligible and non-descriptive to the general public.

VI.

Conclusion.

On the foregoing argument, plaintiff-petitioner submits that the Circuit Court of Appeals was in error in the several respects covered by the petition and brief; that its errors are in matters of general importance to the public in relation to the scope and application of federal trademark law; that it has departed from doctrines announced by this Court; and that its judgment is entirely erroneous.

Wherefore, your petitioner prays that its petition be granted; that the writ of certiorari be issued and the cause reviewed; and that the judgment of the Circuit Court of Appeals for the Seventh Circuit be reversed.

Respectfully submitted,

Ross O. Hinkle,
Attorney for Petitioner.

Leon F. Shackell,
Of Counsel.

APPENDIX A.

Pertinent Sections of Trade-Mark Act of 1905
(U. S. C. Title 15 §§ 85, 96, 98, 101)

"§ 85. Trade-marks which may be registered.

* * *

" * * * *Provided*, That no mark which consists * * * merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, * * * shall be registered under the terms of this subdivision of this chapter: * * * *and provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States or with Indian tribes which was in actual and exclusive use as a trade-mark of the applicant, or his predecessors from whom he derived title, for ten years next preceding February 20, 1905: * * *.

* * *

"§ 96. Evidence of ownership; infringement, and damages therefor.

"The registration of a trade-mark under the provisions of this subdivision of this chapter shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or

colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. Feb. 20, 1905, c. 592 § 16, 33. Stat. 728.

* * *

"§ 98. Review by Supreme Court.

"Writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under this subdivision of this chapter in the same manner as provided by section 347 of Title 28, Judicial Code and Judiciary. Feb. 20, 1905, c. 592, § 18, 33 Stat. 729.

* * *

§ 99. Injunctions; recovery and assessment of damages.

"The several courts vested with jurisdiction of cases arising under this subdivision of this chapter shall have power to grant injunctions, according to the course and principles of equity, to prevent the violation of any right of the owner of a trade-mark registered under said subdivision, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trademark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. The court shall have the same power to increase such damages, in its discretion, as is given by section 96 of this chapter for increasing damages found by verdict in ac-

tions of law; and in assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed. Feb. 20, 1905, c. 592 § 19, 33 Stat. 729.

* * *

"§ 101. Restrictions on actions for infringement.

"No action or suit shall be maintained under the provisions of this subdivision of this chapter in any case when the trade-mark is used in unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or has been abandoned, or upon any certificate of registration fraudulently obtained. Feb. 20, 1905, c. 592, § 21, 33 Stat. 729."

APPENDIX B.

Pertinent portions of the trial testimony of Dr. William Norman Brown, Professor of Sanskrit, University of Pennsylvania.

Mr. Beeken:

Q. I show you one of plaintiff's game sets, bearing the notation 'Parcheesi,' and which has been marked Plaintiff's Exhibit ABH, and would ask you if you are familiar with it, and, if so, please relate the circumstances under which you became acquainted with plaintiff's game bearing this notation.

* * *

A. I am familiar with the game. When I was 7 years old, Christmas of 1899, I received a game Parcheesi, a set of Parcheesi, as a present, and I have been familiar with it since. I kept it for a good many years because I went to India the following summer, August of 1900, and took it with me and played with it a great deal there. I left it in India when I came back at the age of 13.

Q. You say you took the game set of Parcheesi

with you to India. Will you please tell us your experience in playing with it in India?

* * *

A. I played the game in India with my sister, older than I, and sometimes with my parents and sometimes with other American children or with children of English descent. I tried sometimes to play this game with Indians because the game was marked 'A Royal Game of India,' and that had interested me as a child, the fact that it was a game of India, and I assumed that the Indians would know something about it, when I went out there. I had very vague notions of India, of course, but I had been interested in that one fact that I owned something Indian before I went to India, but I can remember that when I tried to play with Indians, not very many times, that we never arrived at any successful conclusion of the game because we couldn't understand each other. They weren't used to playing the game as I played it because, of course, I used a pair of dice which are given with the game and the servants, the few that I tried it with, who seemed to think they knew something about it, wanted to play with Cowries, shells. A Cowrie is a small shell which is used as a very low unit of money. They wanted to play with Cowries, and I knew nothing about the use of Cowries, so that the playing of the game by me with Indians was entirely unsuccessful.

Mr. Beeken:

Q. Do you remember whether or not you had a set of rules with you?

A. Yes, I had a set of rules.

Q. As part of your game set?

A. Yes, and, of course, I naturally took those rules to be correct, and when they thought of something different from those rules, that seemed to me to be incorrect. I am afraid that I wasn't open to very much argument with them.

Q. Have you an Indian Hindi game set of Pachisi? If so, will you please produce and explain it?

A. May I just put this here?

Q. Yes.

The Court: Yes, you may.

A. Now, I have brought along one that belongs to the University of Pennsylvania Museum. This is the cloth on which the game is played. Would you like me to spread it out somewhere?

The Court: You may spread it out.

A. These are some of the men, and these are the Cowries, shells, which we used for playing the game. The University of Pennsylvania Museum has owned this for a number of years. At one time there were five shells. One has been lost, so now only four are here. The Museum records show that there were five, and that is the set. They are loaded with lead.

• • •

The Court: May I interrupt you a moment?

Q. The shells, Cowries, as you call them, do they have spots marked on them similar to the dice have, different spots?

A. No. The method of counting is determined by the number of openings or tops that fall.

Q. In other words, that roll that you just made there, that would count one, assuming that the fourth one was down like that; is that it?

A. I can't remember what that counts. I don't remember what that counts.

Mr. Beeken: We have a reference here that shows exactly the different counts.

The Court: All right go ahead.

• • •

Q. Now, what does the Hindi word Pachisi mean?

A. The Hindi word Pachisi means something that has in it 25, has in it the character and quality of 25. That is its fundamental meaning, and it is so used normally throughout the language.

• • •

Q. Does the Hindi word Pachisi always mean the game and nothing else?

A. No. As a matter of fact, as I said, it means anything, any collection of 25 objects. One of the best known usages of Pachisi is in the title of a very well-known work called the 'Baital-Pachisi.' That means the 25 stories of a goblin. 'Baital' means goblin or vampire, and the 'Pachisi' means the 25. Literally it means the goblin 25 collection, and it is a collection of 25 stories alleged to have been told to a mythical king by a demon inhabiting a corpse which the king was trying to carry for an ascetic from one spot to another.

Q. Is it used in any other connection in the language?

A. Oh, yes.

Q. Give us some other instances.

A. It is used to indicate, as I say, a group of any 25. It may be used to indicate a group of 25 years, especially the first 25 years of a person's life, the first quarter century of one's life. There is also a rather peculiar usage which I remember puzzled me very much once when I was a child, in which in buying cheap things, like fruit, or in this case it happens to be bundles of grass we were buying to store up for our horse and buffalo, they are sold not by the hundred but by the 125, by the 5 Pachisi; that is to say, because the object is so cheap, when you buy a hundred, you pay for a hundred, you really get 125.

The Court:

Q. They throw in an extra 25?

A. Yes.

Mr. Beeken:

Q. Like a baker's dozen?

A. It is like a baker's dozen. I can remember when I was 9 years old and found there was a quarrel between our servants and some villagers who were selling this grass, and they were claiming that they weren't getting the full 125 for our hundred. I complained to my father thinking that our servants were being unfair to the villagers, and then my father had

to explain all this to me, that it was an understood thing.

Q. So, as I understand your testimony on this point, Pachisi, the Hindi word Pachisi, might refer to any collection of 25 things like apples or anything else?

A. Yes; oh, quite right.

* * *

Q. Do the Indians ever use dice instead of Cowries in playing their games?

A. They play the game of Chaupar with dice. Now, the dice which they use are not the same as our dice. We use cubical dice, but the dice which they use for Chaupar are stick dice, and I borrowed a set of those from the University of Pennsylvania Museum and brought them along, if you care to look at them. These dice are marked, of course, on only four sides. They are 6-sided, obviously, but the two ends have no significance and the markings are only on the four sides, and you will see that they are marked 1 and 2 and 5 and 6.

Q. Do those dice belong to the Museum too?

A. They belong to the Museum and I borrowed them.

Q. I believe that you have a photograph of the dice which I would like to offer in evidence, if I may.

A. Yes. That is a photograph of these three dice.

Mr. Farmer: No objection.

Mr. Beeken: I offer that in evidence as Plaintiff's Exhibit HB.

The Court: HB is a photo of the oblong dice, is it?

A. Stick dice or long dice, we speak of them.

The Court: It will be received.

(Said photograph, marked "PLAINTIFF'S EXHIBIT HB", so offered, was thereupon received in evidence.)

Mr. Beeken:

Q. Is it possible to throw a count of 25 with these stick dice?

A. No. The highest count you can throw with them

is 18 because 6 is the largest number on any of them.

Q. The Hindi word Pachisi could not, therefore, be applied to any throw or any count of the throw of stick dice; is that correct?

A. It could not, no.

The Court: Just a minute.

Q. Do you claim this game that they were used with was Chausar or Chaupar?

A. Both. Both names are applied to that game, and I am sorry I didn't mention Chausar when I mentioned Chaupar. Chaupar is the commoner.

Mr. Beeken:

Q. That was just the point I was going to ask, if the game is called Chaupar or Chausar when you use the stick dice; is that correct?

A. That is true, yes.

Q. Now, you have mentioned the words 'Chausar' and 'Chaupar.' What is the meaning of these words, if you know?

A. Well, 'Chaupar' is applied to this board. I am calling it 'board' here; of course, it is a cloth. It is the surface or object used for the playing of the game Chaupar, and it means that which has four sections, each one of which is called 'par'. The first part of it means four; 'Chau' means four, and 'par' is the name of each one of those sections.

Q. Each one of the arms?

A. Each arm, yes, and the same is true with Chausar, and the word 'Chausar' means that which has four 'sars', four parts, each called a 'sar'. Chausar may be used for more things than just this board.

Q. What is the name of this board. is it Chaupar or Chausar or Pachisi?

A. Well, the board is Chaupar or Chausar. The board wouldn't be called Pachisi.

Q. And you say that the meaning of those words is that which has four limbs or four sections, or something like that. Is there any analogy to our game of baseball?

A. Well, yes. We play a game called baseball because it has bases.

Q. And it gets its name from that striking characteristic of the game; is that the point?

A. That is right.

Q. And so with the Chausar or Chaupar cloth board?

A. Yes.

• • •

The Court: Let me see if I am certain about this.

Q. Then if you use these shells which are—what do you call them?

A. Cowries.

Q. Then when you use shells or Cowries, then the game would be known as Pachisi?

A. That is right.

Q. And in that kind of game a total of 25 could be thrown?

A. Yes.

Q. But if you use the stick dice, then you get into the other game of Chaupar?

A. That is right.

Q. Or Chausar?

A. Yes.

Q. And in that kind of a game 25 could not be thrown?

A. That is right.

The Court: All right.

SEP 11 1944
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1944.

No. 382

SELCHOW & RIGHTER COMPANY,
Petitioner,

vs.

WESTERN PRINTING & LITHOGRAPHING COMPANY AND WHITMAN PUBLISHING COMPANY,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

CASPER W. OOMS,
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BENJAMIN H. STERN,
JEROME J. FOLEY,
HARRY BUCHMAN,
Of Counsel.

THE GUNTHORP-WARREN PRINTING COMPANY, 810 WEST JACKSON, CHICAGO

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Respondents.

SUMMARY STATEMENT OF MATTER INVOLVED.

Petitioner, in its summary statement, has limited itself to the several pleadings and the decision of the District Court. It would seem proper to set forth the basic facts and the real issues involved in this litigation:

Petitioner (plaintiff in the courts below) and predecessors for more than ten years prior to the passage of the 1905 Act manufactured and sold in this country a pursuit game under the mark "Parcheesi" and under such mark usually employed the words "A Royal Game of India". On or about October 8, 1918, Petitioner's predecessor registered the mark "Parcheesi" under Section 5 of the Trade-mark Act of 1905, declaring, as required by the

statute, that the mark "has been in actual use as a trademark of the applicant and applicant's predecessors from whom title was derived, for ten years next preceding February 20, 1905" (R. 811).

In about April of 1939 Defendants (Respondents) manufactured and distributed the same game packaged in blue and with a blue-covered playing board and designated it as:

"Parchesi
A Game of India."

Thereafter, Defendants discontinued the use of the word and dress above described and its assurances to desist were accepted by the District Court.

Upon motion of Petitioner in the District Court, before trial Respondents were enjoined from manufacturing and distributing the game in that form. The Circuit Court of Appeals on appeal from the order granting the preliminary injunction affirmed on the balance of injury and convenience theory (112 Fed. (2d) 430). The injunction was dissolved at the trial since, among other things, the evidence showed that Petitioner had not only been manufacturing and distributing a "blue" game, as appeared from the affidavits in support of the injunction, but had been manufacturing and selling the game under several different colors, dress and appearance (R. 769).

Before the trial of the issue, Defendants had begun to manufacture and distribute a game labeled:

"Whitman's
Pachisi
A Game of India"

dressed in a "red or orange" color with the words appearing in white letters, wholly distinctive from Petitioner's dress. It is the manufacture and distribution of the red or orange game with the imprint thereon "Whitman's Pachisi, A Game of India" that is at issue in this cause.

The word "pachisi" is the generic name of the game manufactured both by Petitioner and Respondents. The game originated in India hundreds of years ago and is well known as the national game of India. It was later introduced into this country.

There was no proof that Petitioner's mark "Parcheesi" has acquired a secondary significance. On the other hand, there was proof that the public accepted the word and understood the word only in its primary significance and the Trial Court finding to that effect (R. 774, 783) was approved in the Circuit Court of Appeals (R. 826).

The sole question at issue in this case and presented to the courts below is: where a registrant registers a mark generic to the merchandise to which it is attached, under the ten-year proviso of the 1905 Act, does such registration give to the registrant the exclusive use of such generic term, or may others make a proper use of such generic term in its primary sense?

It has long been settled under federal and local law that unless the registrant under the Act or user of a mark consisting of a surname, or a geographical term, or a generic or descriptive term, has acquired a secondary meaning for his mark, he has no exclusive use thereof, but others may use the same so long as they use reasonable

care to inform the public of the source of the product and differentiate their goods from those manufactured and sold by the user or registrant of the mark.

The petition for certiorari should be denied.

Respectfully submitted,

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ARGUMENT.

Proposition 1: We are in accord with Petitioner's proposition numbered (1), that under a registration pursuant to the Act of 1905 all questions involved in an action for infringement of trade-mark are Federal questions, but we disagree with Petitioner's implied conclusion that the lower courts were governed by "local law relating to common law trade-marks or unfair competition." The opinions below make it clear that the Federal law was applied.

Proposition 2: We are also in accord with Petitioner's proposition numbered (2), that after validating Petitioner's Federal registration, the court below should have applied the statutory tests of infringement. The courts below did so. Their opinions leave no doubt of this.

Both propositions being co-related, to avoid repetition, our discussion of them will be consolidated.

Petitioner's claim that the District Court and Circuit Court of Appeals applied "local law" and not "federal law" is entirely unfounded. Petitioner only creates confusion when in its proposition (1) (Pet. Br. p. 14) it states the courts' decision is "governed by Federal law and not by local law relating to common law trade-marks or unfair competition." No issue has arisen on that score except the illusion Petitioner attempts to create with improper juxtaposition of the words. The Federal law was applied.*

Under the common law, words consisting of (1) names of persons, (2) geographical names, (3) descriptive of the character (generic), or (4) descriptive of the quality, were

* Petitioner was of that same opinion when it filed in the Circuit Court of Appeals its Statement of Points upon which Plaintiff-Appellant intended to rely. It reads: "8. The District Court erred in not applying local law under the doctrine of *Erie* v. *Tompkins* to determine the substantive issues in this action (R. 789)."

not valid exclusive trade-marks, since others had a legitimate right to use them in their primary sense. (See *Armstrong Co.* v. *Nu-Enamel Corp.*, 305 U. S. 315, 335, and cases there cited.)

In the 1905 Act these several categories, denominated in the Act as "marks", were permitted registration upon proof of exclusive use thereof for ten years prior to the passage of the Act. However, such registration could not and did not give to the registrant exclusive use thereof. Others had the right to use the words in their primary sense so long as they did not mislead the public as to the origin and ownership of their goods.

The proposition of law is clearly stated by this court in *Thaddeus Davids Co.* v. *Davids Inc.*, 233 U. S. 461, and both the lower courts in the case at bar followed the precepts and principles therein established. That is the Federal Law on the subject. We beg leave to quote from pages 469-470 of the *Thaddeus Davids* opinion.

(In the quotation we will present in ordinary type that part quoted by petitioner (Pet. Br. p. 21), and in bold type we include that portion of the opinion omitted in Petitioner's brief, as there indicated by asterisks.)

> "This provision applies to all trade-marks that are within the act, including those which come under the ten-year clause, provided they are not used 'in unlawful business', or 'upon any article injurious in itself', or 'with the design of deceiving the public', and have not been 'abandoned' (§ 21).
>
> But, while this is true, the inquiry as to the extent of the right thus secured by the statute, in the case of marks which are admitted to registration under the ten-year clause, is not completely answered. **It is apparent that, with respect to names or terms coming within this class, there may be proper uses by others than the registrant even in connection with trade in similar goods. It would seem to be clear, for example,**

that the registration for which the statute provides was not designed to confer a monopoly of the use of surnames, or of geographical names, as such. It is not to be supposed that Congress intended to prevent one from using his own name in trade, or from making appropriate reference to the town or city in which his place of business is located; and we do not find it necessary to consider the question of the validity of such an attempt if one were made. Congress has admitted to registration the names or terms belonging to the class under consideration simply because of their prior use as trade-marks, although they had not been such in law. Their exclusive use as trade-marks for the stated period was deemed in the judgment of Congress a sufficient assurance that they had acquired a secondary meaning as the designation of the origin or ownership of the merchandise to which they were affixed. **And it was manifestly in this limited character only that they received statutory recognition, and, on registration, became entitled to protection under the act.**

In the case, therefore, of marks consisting of names or terms having a double significance, and being susceptible of legitimate uses with respect to their primary sense, the reproduction, copy or imitation which constitutes infringement must be such as is calculated to mislead the public with respect to the origin or ownership of the goods and thus to invade the right of the registrant to the use of the name or term as a designation of his merchandise. This we conceive to be the meaning of the statute."

It cannot be controverted that the court in the *Thaddeus Davids* case passed upon the propriety of the exclusive use by the Thaddeus Davids Co. of its registration of the surname "Davids" under the ten year proviso of the Act of 1905. We respectfully submit that, from a reading of the decision, it must be concluded that the court held:

(1) A mark consisting of an ordinary surname was not

the subject of exclusive appropriation as a common law trade-mark.[1]

(2) Under the ten-year proviso of the 1905 Act "marks" in the four categories above described were registerable on showing exclusive use by the registrant for ten years prior to the passage of the 1905 Act.

(3) Although registration was permitted by the statute of these marks, "it is apparent that, with respect to names or terms coming within this class, there may be proper uses by others than the registrant even in connection with trade in similar goods."[2]

(4) In the case of marks susceptible of legitimate uses in their primary sense, "infringement must be such as to mislead the public with respect to origin and ownership of goods."[2]

It would seem unnecessary to repeat the Summary Statement of Matter Involved in the case at bar to show applicability of the principles applied in the *Thaddeus Davids* case to it, but it would not be amiss to state that concededly Respondents do not use the dress, color or lettering of Petitioner's game but simply use the generic name of the game and in large letters identify Respondents as the manufacturer and distributor so that no possible confusion can exist respecting origin or ownership of the goods of Respondents.

The Circuit Court of Appeals properly quoted the District Court as saying that "the applicable tests in this case were the old common law rules of unfair competition." (142 F. 2d 709.) But by that statement neither of the courts said, or meant, or intended "local law" as Petitioner would have us believe. Both courts followed

1. 233 U. S. 464: "As the mark consisted of an ordinary surname, it was not the subject of exclusive appropriation as a common law trademark (*Brown Chemical Company* v. *Meyer*, 139 U. S. 540, 542; *Howe Scale Company* v. *Wyckoff*, 198 U. S. 118, 134, 135)."

2. 233 U. S., page 470.

strictly the precepts of the *Thaddeus Davids* opinion in this connection and used language approved by this court.

In the *Thaddeus Davids* opinion at page 469, Mr. Justice Hughes applied the statutory test of infringement, quoting from Section 16 of the Trade-mark Act, which states that one who shall "reproduce, counterfeit or copy or colorably imitate any such trade-mark" shall be liable for infringement.

Then, at page 471, the court construed this statutory language with respect to the four categories of "marks" and stated, in effect, that it means the ordinary rules of unfair competition without proof of wrongful intent to defraud or facts justifying the inference of such intent.

Here again, Petitioner's quotation (Pet. Br. p. 18) of what the Circuit Court of Appeals said (142 F. 2d 708-709) about the District Court's opinion requires amplification, and again we include in bold type the portion of the quotation omitted by Petitioner as indicated by asterisks.

> "**In Thaddeus Davids Co. v. Davids Mfg. Co., 233 U. S. 461, it was held that the Act of 1905 was not intended to change the common law principles of trademarks. The courts have held that the only rights given to the owner of a mark registered under the ten year clause which he did not have at common law are the right to institute suits for infringement in the federal courts irrespective of diversity of citizenship, and without the necessity of showing wrongful intent on the part of the defendant.** The District Court therefore concluded that the applicable tests in this case were the old common law rules of unfair competition with the exception of the requirement of proof of an attempt to defraud. See *Armstrong Paint and Varnish Works* v. *Nu-Enamel Corp.*, 305 U. S. 315. The ruling of the District Court in this respect, we think, was proper, and the only question left for determination is whether the plaintiff is entitled under the common law to exclude the defendant from the use of the word 'Pachisi'." (R. 826.)

From the foregoing it is conclusive that the Circuit Court of Appeals did not apply the "local law" but the Federal law. It repeated that the Thaddeus Davids case held, "the Act of 1905 was not intended to change the common law principles of trade-marks," but needless to say it was deciding the issues under the 1905 Act.

The term "common law" is quite different from the term "local law". The term "common law" is often and properly used to distinguish Federal case law from statutory law. There is ample and sufficient authority from this court justifying such use. (See *Armstrong Co.* v. *Nu-Enamel*, 305 U. S. 315, 335; *Western Union Telegraph Co.* v. *Call Publishing Co.*, 181 U. S. 92, 101, 102; *Kansas* v. *Colorado*, 206 U. S. 46, 96, 97.) The *Kansas* v. *Colorado* case, citing the *Western Union* case, said at page 96:

> "Can it be that the great multitude of interstate commercial transactions are freed from the burdens created by the common law as so defined, and are subject to no rule except that to be found in the statutes of Congress? We are clearly of opinion that this cannot be so, and that the principles of the common law are operative upon all interstate commercial transactions except so far as they are modified by Congressional enactment."

Since both lower courts did not apply "local law" to the issues presented in the case at bar, there is no conflict between the cases of, *Dwinell-Wright Co.* v. *National Fruit Products Co.*, 140 Fed. (2d) 618, which held (page 620):

> "The court below concluded that on the question of infringement of registered trade-marks the applicable law is federal statutory law, and where that is ambiguous or silent, federal case law, and we agree."

and *Philco Corp.* v. *Phillips Mfg. Co.*, 133 Fed. (2d) 633, and *Sola Electric Co.* v. *Jefferson Electric Co.*, 317 U. S. 173.

Pecheur Lozenge Co. v. *National Candy Co.*, 315 U. S.

666, is not applicable since the alleged trade-marks "Pay Roll" and "Cash Roll" are not in any of the four categories embraced in the ten year proviso of the Act.

This discussion, we submit, eliminates "Reasons Relied on for the Allowance of the Writ, Nos. 1, 2 and 5."

Reasons Nos. 3 and 4 simply require the statement that the *Thaddeus Davids* case did not discuss the proposition of secondary meaning, for it is difficult to fathom how the surname "Davids" could lose its primary meaning as a surname. Moreover, the court found as a fact that the Petitioner did not attain a secondary meaning for its "mark" (Finding 20, R. 783). A succinct discussion of what constitutes acquisition of secondary meaning appears in the *Shredded Wheat* case, *Kellogg Co.* v. *National Biscuit Co.*, 305 U. S. 111, 118.

Dixi-Cola Laboratories v. *Coca-Cola Co.*, 117 F. 2d 352 (cert. d. 314 U. S. 629) is authority for the effect of a registration under the 1905 Act. The court said at page 353:

> "The District Judge concluded that these registrations were valid, but it is not necessary for us to decide the point here for, as the judge also held, the substantive rights under a trade-mark are not dependent upon or affected by registration, and its secondary, as distinguished from its primary significance, is still open to question. *Thaddeus Davids Co.* v. *Davids Mfg. Co.*, 233 U. S. 461, * * * (other cases)."

An even clearer statement of the rule appears in *Walgreen Drug Stores* v. *Obear-Nester Glass Co.*, 113 F. 2d 956 (cert. d. 311 U. S. 708), where the Court stated at page 960, referring to the 1905 Act:

> "Mere registration under the Federal Act does not create a trade-mark and confers no new rights to the mark claimed, nor, indeed, any greater rights than already existed at common law without registration."

This leaves only Reason No. 6, which will be discussed in the next proposition.

Proposition 3: Petitioner's mark "Parcheesi" is the generic term in connection with the merchandise with which it is used not only upon Respondents' evidence, but by Petitioner's own admissions, and even more important, "pachisi" is the generic term for Respondents' game.

In this proposition Petitioner is challenging a finding of fact of the District Court and affirmed by the Circuit Court in the following language (R. 824; 142 F. 2d 708):

> "The following facts are supported by substantial evidence, concerning which there is but little disagreement, if any.
>
> As early as 1869, a game similar to the plaintiff's 'Parcheesi' was played in India. It was then referred to as the national game of India, and was designated by a word of the language of that country which sounded very similar to 'Parcheesi,' or 'Patcheesi,' or 'Pachisi.' 'Pachisi' is the correct spelling of the Indian name."

We do not presume to know, and we challenge Petitioner's clairvoyance to conjecture, what testimony in the cause was regarded credible and what was rejected by the Trial Court. Suffice it to say that the evidence overwhelmingly supports the Court's finding that "pachisi" not only was, but still is, the generic term for the pursuit game manufactured by both litigants. Exhibit No. 5, (R. 659-698 introduced in evidence at R. 151), contains numerous generic references thereto running from Bayard Taylor's book "A Visit to India, China and Japan," published in this country in 1855, which reads (Item 22, R. 666):

> " 'Within these fairy precincts lie the gardens, still overrun with roses and jasmine vines, in the midst of which fountains are playing. There is also a court, paved with squares of black and white marble, so as to form a parchisi board. This is a game resembling backgammon, but, instead of ivory pieces, it was played on this colossal board by Akbar and his wives, or eunuchs, with girls, who trotted from square to square, as the moves were made."

to references in multifarious fiction, dictionaries and game books, down to the twentieth century, and in several languages. Defendants' Exhibit 6 (R. 699 to 701, introduced at R. 152), discloses a generic reference in the year 1800. Similar disclosures appear in other exhibits to and including Exhibit 22, and considerable other evidence, much of it published by Petitioner itself (R. 563, 645, 655, 659).

By its own application for registration Petitioner admitted that its mark was generic (R. 811). In the *Dixi-Cola case*, 117 F. 2d 352, 356, the court treated registration under the ten-year clause as an admission that the word was descriptive. In *Selchow et al.* v. *Chaffee & Selchow Mfg. Co.*, 132 Fed. 996, (at page 997) the court found that the name of the game might be pronounced "parchise," "pucheese" and "putcheese" and held that the defendant was not precluded from selling the game under its true and correct Hindu name.

Moreover, it does not become Petitioner to say Parcheesi or pachisi is not, as Petitioner has long advertised it, "A Game of India." Were that not the fact it would be in this court with unclean hands.

The case of *LeBlume Import Co.* v. *Coty*, 2 Cir., 293 Fed. 344, is not applicable. There the court found that the trade-mark "L'Origan" was not descriptive of the product with which it was used (page 351), and moreover, that the registrant's mark had attained secondary meaning (page 353).

It is interesting to note that the Supreme Court disagreed with the dicta of the Circuit Court of Appeals (Second Circuit), in the Coty case to the effect that words not generally known in this country are non-descriptive. In *United States* v. *Coca Cola Co.*, 241 U. S. 265, in replying to the contention that "coca" was not known to the

public and therefore non-descriptive, the court said at page 288:

> "Nor would it be controlling that at the time of the adoption of the name the coca plant was known only to foreigners and scientists, for if the name had appropriate reference to that plant and to substances derived therefor, its use would primarily be taken in that sense by those who did know or who took pains to inform themselves of its meaning. Mere ignorance on the part of others as to the nature of the composition would not change the descriptive character of the designation."

Coca-Cola Co. v. *Nashville Syrup Co.*, 215 Fed. 527, is not applicable. It held (page 530) that Coca Cola had acquired a secondary meaning.

We note with interest the statement in Petitioner's brief, that the Indians used cowry shells to play "pachisi", while in this country we use cube dice. Suffice it to say that their similarity even extends to the common quality that both can be "loaded" (R. 32).

This presentation dissolves Reason No. 6, and all of Petitioner's specifications of error fall from the foregoing discussion.

Respectfully submitted,

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FILED
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CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1944.

No. 382

SELCHOW & RIGHTER COMPANY,
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WESTERN PRINTING & LITHOGRAPHING COMPANY and WHITMAN PUBLISHING COMPANY,
Respondents.

PETITIONER'S REPLY TO RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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PETITIONER'S REPLY TO RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Respondents' brief in opposition to Petitioner's Petition for Writ of Certiorari fails to point out wherein a single reason relied upon for the allowance of the writ is not presented by the case at bar. Nowhere in respondents' brief are the "Questions Presented" by the Petition even alluded to; nowhere is it even hinted that they are not

presented by the case at bar or that they are not sufficiently important to warrant this Court's review.

I.

Respondents, although agreeing with petitioner's Propositions (1) "that under a registration pursuant to the Act of 1905 all questions involved in an action for infringement * * * are federal questions" and (2) that "the court below should have applied the statutory tests of infringement," attempt to dismiss the subject and base their opposition almost entirely upon their unsupported statement that "The opinions below make it clear that the Federal law was applied."

On the contrary, we say that the opinions of the courts below make it clear that both applied tests of "the old common law rules of unfair competition" and purported to extend to the plaintiff-petitioner only such protection as was afforded "under the common law," notwithstanding the fact that a valid federal trade-mark registration under the Act of 1905 was involved.

The words just quoted were taken verbatim from the opinion of the Circuit Court of Appeals, and we submit it is proper to assume that that court meant what it said and also had in mind that this Court said in *Erie Railroad Co.* v. *Tompkins*, 304 U. S. 64: "There is no federal general common law."

Consequently we submit that it was proper to consider that the Circuit Court of Appeals applied, as it said it did, principles of common or local law whereas (in accord with respondents' counsel) we say the courts below should have applied federal statutory law.

Surely, then, there is here presented an important question which this Court should decide, which it intended to decide in *Pecheur Lozenge Co.* v. *National Candy Co.*, 315

U. S. 666, but which it was there precluded from deciding because "the suit was not founded upon a trade-mark registered under the 1905 Act, as the bill of complaint had made it appear."

Furthermore, the application by the court below of "tests applicable" under "the old common law" brings it into direct conflict with its own decision in *Philco Corp.* v. *Phillips Mfg. Co.*, 133 F. (2d) 663, with the decision of this Court in *Sola Electric Co.* v. *Jefferson Electric Co.*, 317 U. S. 173, and with the decision of the Second Circuit Court of Appeals in *Dwinell-Wright Co.* v. *National Fruit Product Co.*, 140 F. (2d) 618.

II.

The decision of the court below conflicts, in at least three vital respects, with the controlling decision of this Court in *Thaddeus Davids Co.* v. *Davids*, 233 U. S. 416.

1. The court below said that "the applicable tests in this case were the old common law rules of unfair competition"; whereas this Court said in the *Davids* case, at page 471 of 233 U. S.:

> "* * * This is not to say that, in this view, the case becomes one simply of unfair competition, as that category has been defined in the law; for, whatever analogy may exist with respect to the scope of protection in this class of cases, still the right to be protected against an unwarranted use of the registered mark has been made a statutory right, * * *." (Pet. Br. pp. 22-23.)

2. The court below approved the ruling of the District Court that petitioner (plaintiff-appellant below) must make an affirmative showing that its trade-mark "Parcheesi" had acquired a secondary meaning; whereas in the *Davids* case, without any reference to whether proof had been adduced to show acquisition of a secondary meaning by the surname "Davids", — which had been registered under the ten-year proviso of the Act of 1905, — this Court, with reference to marks so registered, said at page 470 of 233 U. S., that

> "* * * Their exclusive use as trademarks for the stated period was deemed, in the judgment of Congress, a sufficient assurance that they had acquired a secondary meaning as the designation of the origin or ownership of the merchandise to which they were affixed. * * *" (Pet. Br. pp. 21-22.)

3. Both courts below held petitioner's federal registration of its trade-mark "Parcheesi" to be valid and not abandoned; yet, in denying to petitioner the protection to which, — as this Court said in the *Davids* case, at page 469 of 233 U. S. — petitioner is entitled on due registration, the courts below did not even hint that they had considered the question whether or not respondents' red game of "Whitman's Pachisi" was a "reproduction, counterfeit, copy or colorable imitation" of "Parcheesi" within the meaning of Section 16 of the Act of 1905, as construed in the *Davids* case (Pet. Br. pp. 21 (first paragraph), 23-24).

Respectfully submitted,

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